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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,261	07/11/2007	Lars Michael Larsen	LARSEN 5	6440

1444 7590 04/02/2012

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EXAMINER	
FAY, ZOHREH A	

ART UNIT	PAPER NUMBER
1627	

MAIL DATE	DELIVERY MODE
04/02/2012	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/593,261	LARSEN, LARS MICHAEL	
	Examiner	Art Unit	
	ZOHREH FAY	1627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 June 2012*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

5)☒ Claim(s) *59-61,79 and 108-118* is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6)☐ Claim(s) _____ is/are allowed.

7)☒ Claim(s) *59-61,79 and 108-118* is/are rejected.

8)☐ Claim(s) _____ is/are objected to.

9)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

10)☐ The specification is objected to by the Examiner.

11)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

12)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/13/2007, 5/20/2008, 10/29/2010, 12/13/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Jne 6, 2011 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 59-61, 79 and 108-118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campochiaro et al. (US 5,824,685) in view of Oikawa et al. (submitted by the applicant).

Campochiaro et al. teach the use of the claimed retinoids, such as, Formula V for the treating proliferative retinopathy. See the abstract, column 3, lines 49-64, column 4, lines 30-65, claims 1-12 and table 3. Campochiaro et al. differs from the claimed invention in using the compounds for the treatment of non-proliferative diabetic retinopathy. Oikawa et al. teach the use of the compounds within the scope of formula I for the treatment of diabetic retinopathy. The above reference makes clear that the genus of compounds of Formula V, have been previously used for the treatment of diabetic retinopathy. See the entire document. It would have been obvious to a person skilled in the art to use compound of formula V for the treatment of diabetic retinopathy, motivated by the teachings of Oikawa et al., which teach the genus of compound V has been previously used for the treatment of diabetic retinopathy. It would have been further obvious to use the compounds of Campochiaro et al. for the treatment of diabetic retinopathy, considering that diabetic retinopathy is an angiogenic proliferative disease, and the use of the claimed compounds for the treatment of proliferative retinopathy is expected to be useful for the treatment of diabetic retinopathy. Applicant has presented no evidence to establish the unexpected or unobvious nature of the claimed invention, and as such, claims 59-61, 79 and 108-115 are properly rejected under 35 U.S.C. 103 (a).

Applicant's arguments and remarks have been carefully considered, but are not deemed to be persuasive. Applicant in his remarks argues that Oikawa relates to the use of retinoids for the treatment of proliferative diabetic retinopathy and not non-proliferative diabetic proliferative. It is the examiner's position that proliferative diabetic

retinopathy is the advanced stage of non-proliferative diabetic retinopathy. Therefore, it would have been obvious to a person skilled in the art to use a compound being used for the treatment of proliferative retinopathy and use it for the treatment of non-proliferative diabetic retinopathy. Applicant's arguments regarding the Campochiaro have been noted. Campochiaro is used to show that the claimed compounds are retinoid agonists being used for the treatment of retinal disorders. To substitute the claimed retinoid agonists for the structurally similar retinoid agonists of Oikawa and use them for the treatment of diabetic retinopathy would have been obvious to a person skilled in the art in the absence of evidence to the contrary. It is also the examiner's position that if a compound is used for the treatment of proliferative diabetic retinopathy it is expected that such compound would treat non-proliferative diabetic retinopathy, considering that such disorder in encompassed by proliferative diabetic retinopathy, which is the later stages of diabetic retinopathy. Furthermore, the use of the claimed compounds in the body for any purpose is expected to reduce the risk of getting diabetic retinopathy.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ZOHREH A. FAY whose telephone number is (571)272-0573. The examiner can normally be reached on Monday to Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ZF
/Zohreh A Fay/
Primary Examiner, Art Unit 1627

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